UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,518	05/09/2005	Gunther Beisel	FI-52PCT	4424

40570 7590 12/15/2006

FRIEDRICH KUEFFNER
317 MADISON AVENUE, SUITE 910
NEW YORK, NY 10017

EXAMINER	
HENRY, MICHAEL C	

ART UNIT	PAPER NUMBER
1623	

DATE MAILED: 12/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

TH

Office Action Summary	Application No.	Applicant(s)	
	10/511,518	BEISEL, GUNTHER	
	Examiner	Art Unit	
	Michael C. Henry	1623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ *Responsive to communication(s) filed on *18 September 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7 and 12-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7 and 12-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. The following office action is a responsive to the Amendment filed, 9/18/06. The amendment filed 9/18/06 affects the application, 11/322,204 as follows: Claim 7 is amended. Claims 8-11 are canceled. New claim 12-15 have been added. The 102 rejections are maintained.

2. The responsive is contained herein below.

Claims 1-7, 12-15 are pending in the application

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14 -15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 14-15 provide for "the using or the use of an agent ...." but, since the claims do not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

The phrase "regulating cholesterol balance" in claims 13 is a phrase which renders the claim indefinite. More specifically, it is unclear how the administration of said composition can regulate cholesterol balance since the regulation of cholestero requires both increasing and decreasing the cholesterol and would involves opposite mechanism actions. That is, said composition cannot have the effect of increasing and decreasing cholesterol simultaneously.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 14-15 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd.* v. *Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 14, 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Young et al. (GB 1302275).

In claim 1, applicant claims an "Agent for producing a satiety effect and for weight loss consisting of a dried, porous gel or foam of at least one anionic polymer, wherein the agent is present as an aluminum salt. Young et al. disclose applicant's agent consisting of a porous gel of the anionic polymer (alginate), wherein the agent is present as an aluminum salt (aluminum alginate) (see page 1, col. 1, lines 11-22 and claim 1). Young et al.'s agent is a reconstructed or simulated food product that comprises fruit pulp or puree encapsulated in a skin of aluminum

alginate gel (see page 1, col. 1, lines 11-22 and claim 1). It should be noted that the examiner gives little weight to the intended use of the agent since the claim is a composition or compound claim and the said intended use of the composition or compound does not add to the patentability of the composition or compound claimed. Furthermore, since Young et al.'s agent consist of the same gel of the same anionic polymer aluminum salt as applicant's agent (and no other different or distinguishing ingredients) then Young et al.'s agent should inherently provide the same satiety or weight loss effect as applicant's agent. In addition, Young et al.'s disclose that their alginate gel can behave as a semipermeable (page 2, col. 1, lines 14-19). This implies that the alginate gel is porous. Claim 2 is drawn to an agent according to claim 1, wherein the agent is present in compressed form. Young et al. disclose applicant's agent, wherein the agent is present in compressed form (encapsulated form) (see page 1, col. 1, lines 11-22 and claim 1). It should be noted that the examiner considers Young et al.'s encapsulated form of the said agent a compressed form, since said agent is shaped (compressed) into an encapsulated form. Claim 3, which is drawn to an agent according to claim 1, wherein the agent contains alginate or pectin or a combination thereof as the anionic polymer, is also anticipated by Young et al., since Young et al. agent contains aluminum alginate (see page 1, col. 1, lines 11-22 and claim 1). Claim 4, which is drawn to an agent according to claim 1, wherein the agent is present as an aluminum alginate, aluminum pectinate, or combination thereof, is also anticipated by Young et al., since Young et al. agent is present as aluminum alginate (see page 1, col. 1, lines 11-22 and claim 1). Claims 5 and 6 are drawn said agent according to claim 1, wherein the agent also contains active ingredients that include vitamins, trace elements, or medicinal compounds. Young et al. disclose applicant's agent, wherein the agent also contains incorporated aluminum or calcium ion (trace

elements or active ingredients) (see page 1, col. 1, lines 11-22, and claims 1 and 6). Claim 7 is drawn to an agent according to claim 1, wherein the agent is administered in the form of tablets, capsules, coated tablets, granulates, or powders. Young et al. disclose applicant's agent, wherein the agent is in the form of capsules (see page 1, col. 1, lines 11-22, and claim 1). Claims 14 and 15 which are drawn to a method for producing a composition comprising using an agent consisting of a dried, porous gel or foam of at least one anionic polymer, wherein the agent is present as an aluminum salt are also anticipated by Young et al., since Young et al. also use said agent contains aluminum alginate (see col. 1, lines 27-41).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al. (GB 1302275).

In claim 12, applicant claims "a method of producing a satiety effect and for weight loss, comprising providing an agent consisting of a dried, porous gel or foam of at least one anionic polymer; and ingesting the agent.

Young et al. disclose applicant's composition consisting of porous gel or foam of at least one anionic polymer (see page 1, col. 1, lines 11-22 and claim 1). Furthermore, Young et al. disclose that said composition is edible. Young fails to disclose that the composition can provide a satiety effect. However, Young et al's composition should also produce a satiety effect based

on the amount consumed of the composition, the kind of individual that consumes said composition and the appetite of the consumer.

It would have been obvious to one having ordinary skill in the art, at the time the claimed invention was made to produced a satiety effect by consuming have consumed Young et al. composition, depending on factors such as the amount consumed of the composition, the kind of individual that consumes said composition and the appetite of the consumer.

One having ordinary skill in the art would have been motivated to produced a satiety effect by consuming have consumed Young et al. composition, depending on factors such as the amount consumed of the composition, the kind of individual that consumes said composition and the appetite of the consumer.

Response Arguments

Applicant's arguments with respect to claim 1-7, 12-15 have been considered but are not found convincing.

The applicant argues that in contrast, in the presently claimed invention the anionic polymer is not provided for encapsulation, but instead forms on itself the inventive agent. However, the intended use of the agent is does not alter the agent, limit the agent or composition claimed. In fact, applicant like Young also claims his said agent or composition capsule form (see claim 7).

The applicant argues that position that the Young et al's composition would inherently provide satiety effect and weight loss finds no support in the teachings of Young et al. However, Young et al's composition is the same as applicant's claimed composition and consequently it should inherently have the same effect as applicant's.

The applicant argues that position that Young et al. do not disclose a product that can be compressed as can the presently claimed invention. However, Young et al. composition is compressible, especially since is the same as applicant's composition

The Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Henry whose telephone number is 571-272-0652. The examiner can normally be reached on 8.30am-5pm; Mon-Fri. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaojia A. Jiang can be reached on 571-272-0627. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael C. Henry

12/11/06

Shaojia Anna Jiang, Ph.D.
Supervisory Patent Examiner
Art Unit 1623

December 11, 2006.